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OFFICE OF PETITIONS

In re Patent No. 7,099,848 :
Issue date: August 29, 2006 :
Application No. 09/505,486 : DECISION ON PETITION
Filed: February 16, 2000 :
:

This is a decision on the Petition For Expungement of Assignment Record under MPEP 323.01(d), filed March 29, 2012, which is being treated as a petition under 37 CFR 1.182 to expunge an assignment document previously recorded against the above-identified patent application.

The fee for petitions under 37 CFR 1.182 has been charged to petitioner's deposit account as authorized.

The petition is **dismissed**. This is not a final agency action.

Petitioner states that the assignment document recorded at reel/frame number 027831/0484 was recorded in error as it was recorded against the wrong patent.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

- (A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
- (B) the integrity of the assignment records will not be affected by granting the petition.

Petitioner has not proven either item A or B. The petition does not explain or otherwise address that the procedures outlined in MPEP § 323.01(a) through § 323.01(c) do not provide adequate relief and that expungement will not affect the integrity of the assignment records.

Here, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

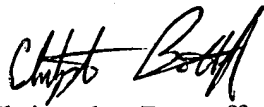
As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document" that explains the nature of the recorded document so as to clarify the assignment records. "Corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313. This would include an explanation of the recorded document so as to clarify the assignment records. The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

The change of address filed on January 28, 2009 was not made by an attorney of record and, accordingly, the address has not been changed. If appropriate, a change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this communication in regard to the petition to expunge assignment documents should be directed to Carl Friedman at (571)272-6842.

A handwritten signature in black ink, appearing to read "Chris Bottorff", written in a cursive style.

Christopher Bottorff
Petitions Examiner
Office of Petitions

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